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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>1219.02</b>	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____		Application Number <b>10/736,427</b>	Filed <b>December 15, 2003</b>
		First Named Inventor <b>Jerry Dennis Sachs, et al.</b>	
		Art Unit <b>2617</b>	Examiner <b>PEACHES, Randy</b>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <b>32,202</b> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> Total of <b>1</b> forms are submitted.			

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jerry Dennis Sacks, et al. Confirmation Number: 3965  
Serial Number: 10/736,427 Examiner: PEACHES, Randy  
Filed: December 15, 2003 Group Art Unit: 2617  
For: SYSTEM FOR PRODUCT Attorney Docket Number: 1219.02  
SELECTION

MAIL STOP AMENDMENT

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REASONS UPON WHICH REVIEW IS REQUESTED

Applicants have filed a notice of appeal and are requesting pre-appeal brief review because Applicants believe that the rejection of claims 1-21 under 35 USC 103(a) as being unpatentable over *Swartz et al.* (U.S. Patent Publication 2003/0020629 A1) in view of *Bunte et al.* (U.S. Patent Number 5,875,070) is improper.

Further Applicant believes that the new matter rejection raised in the Non Final Office Action dated February 21, 2008 was in error.

In response to a Final Office Action dated July 19, 2007 Applicant filed a Request for Continued Examination and filed an amendment therewith on January 18, 2008. The amendment was to better define Applicant's invention and included the limitation that the wearable mobile computer was in direct communication with a user and an order system server.

The Examiner raised a new matter objection to this amendment. However, Applicant believes that Figure 2 of the originally filed Specification clearly shows such an arrangement. The user 20 is shown in communication with the wearable mobile computer 10. The wearable

mobile computer 10 is depicted in communication with order system server 19. The communication is not interrupted by any intermediate communication device. Therefore, Figure 2 discloses an embodiment of the invention wherein the mobile computer is in direct communication with the order system server and the user.

The written description requirement obliges applicant to “convey with reasonable clarity to those skilled in the art, that as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of written description inquiry, whatever is claimed. [See *Ex Parte Marc Odrich et al.*, United States Patent and Trademark Office Before the Board of Patent Appeals and Interferences, Appeal 2008-1260, citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir, 1991)]

To establish a prima facie case of unpatentability based on the written description requirement, “the Examiner must present [] evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.” [See *Id.* Citing *In re Alton*, 76 F. 3d 1168, 1175 (Fed. Cir. 1996)] Therefore, if the specification contains a description of the claimed invention, even if not in the exact words, “the examiner ...; in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient.” *Id.*

Applicants believe they have met the written description requirement because Figure 2 discloses a mobile computer in direct communication with a user and an order server system. The embodiment depicted in Figure 2 would convey to one skilled in the art the Applicants possessed the invention as now claimed.

Claims 1-21 are rejected under 35 USC § 103(a) as being unpatentable over *Swartz et al.* (U.S. Patent Publication 2003/0020629 A1) in view of *Bunte et al.* (U.S. Patent Number 5,875,070).

The Applicants amended claim 1 to better define the invention. Applicants believe that claim 1 as amended appears to teach past the art of record. Applicants’ claim 1 teaches a system

for product selection at a location. Applicants' system includes a mobile computer that communicates directly with an order system server.

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

In the Final Office Action dated July 19, 2007, it was indicated that a host computer 810 in *Swartz* read on Applicants' order system server. *Swartz* teaches that the host computer 810 communicates with the mobile computer through the use of a secondary device 804. [See *Swartz's* Figure 7; and Specification Page 5; Paragraph 0064]. In contrast, Applicants' claim 1 teaches a mobile computer in direct communication with an order system server. [Applicants' Figure 2].

The *Swartz* reference does not teach the limitation of the order server being in direct communication with the mobile computer, wherein the mobile computer is in direct communication with a user. In fact it appears that Figure 7 teaches away from this arrangement.

The Office Action indicated that *Bunte* teaches a wearable mobile computer wherein a text-to-speech software resides in the memory, i.e Flash memory, Ram, etc. Applicants believe that *Bunte* fails to teach a mobile device that communicates directly with an order system server. Applicants believe that for the reasons stated above that Applicants' claim 1 teaches past the art of record.

Since neither *Swartz*, *Bunte*, nor the combination of *Swartz* and *Bunte* teach the mobile computer in direct communication with a user and an enterprise server Applicants believe that the section 103 rejection should be withdrawn with respect to claim 1.

Claims 2 - 21 depend on claim 1, therefore claims 2 - 21 incorporate the limitations of claim 1 and the section 103 rejection to claims 2 - 21 should be withdrawn.

Respectfully submitted,



Date: May 21, 2008

Wendy Buskop  
Patent Attorney  
Reg. No. 32,202

Please mail correspondence to:

The address associated with **CUSTOMER NO. 29637**

BUSKOP LAW GROUP, PC  
4511 DACOMA STREET  
HOUSTON, TEXAS 77092  
(TEL)713-403-7411  
(FAX)713-275-3419